

REMARKS

Responsive to the Restriction mailed Sept. 22, 2010, Applicants **elect the species described with reference to FIGURE 1**, respectfully submit that **at least claims 1-6, 15-31, and 38-41 are readable upon the elected species**, and submit the following comments.

Status of the application

Applicants note that this application has been assigned to a new Examiner.

For the Examiner's convenience, a listing of the currently pending claims is included herewith. There are no claim amendments presented herein.

In view of the restriction (which implies that a new search is to be performed), Applicants understand that all previous rejections are presently withdrawn.

Restriction

The Restriction identifies five patentably distinct species:

Species described with reference to FIGURE 1;

Species described with reference to FIGURES 2A and 2B;

Species described with reference to FIGURE 3;

Species described with reference to FIGURE 4A, 4B, and 4C; and

Species described with reference to FIGURE 5A, 5B, and 5C.

The Restriction asserts:

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph.

Restriction page 2.

Traversal of the Restriction

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. MPEP § 806.04. Claims to different species are mutually exclusive if one claim recites limitations disclosed

for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. *Id.* This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. *Id.*

Applicants respectfully traverse the restriction and ask that it be withdrawn. The following **bases of traversal** are set forth.

"If the search and examination of all the claims in an application can be made without *serious* burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." MPEP § 803 (italics added). The Restriction does not allege that examination of all claims would impose a serious burden, and thus does not meet the threshold requirement for a restriction.

The Restriction does allege a "search burden", and provides a list of alternative bases for this search burden, including that different search queries may be needed. Restriction page 2. Respectfully, the mere need for different search queries for different claims does not, without more, establish a *serious* burden. Indeed, *any* two non-identical claims are likely to require different search queries. The Restriction asserts other alternative bases such as different fields of search (*Id.*), but does not provide evidentiary support for any of these alternative bases. These are merely bald allegations that cannot establish a serious burden. For example, for different fields of search to justify a restriction, "[t]he indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims." MPEP § 808.02. The Restriction does not even *identify* the alleged different fields of search.

A proper Restriction also must identify any generic claims or indicate that no generic claims are present. MPEP § 809.02(a). The Restriction states that no currently pending claim is generic. Restriction page 2. Applicants respectfully traverse, and respectfully submit that at a minimum claims 1 and 39 are each generic to all five species. For example, the species described with reference to FIGURE 1 is a light emitting package as per claim 1 including a chip carrier (14) having top and bottom principal surfaces, at least one light emitting chip (12) attached to the top principal surface of the chip carrier, and a lead frame (40, 42) attached to the top principal surface of the chip carrier but not to the bottom principal surface of the chip carrier.

If the next Office Action maintains the restriction and also maintains that no currently pending claim is generic, Applicants request that the next Office Action explain why claim 1 is not a generic claim.

Election

Notwithstanding the foregoing traversal, **Applicants elect the species described with reference to FIGURE 1. See MPEP § 809.02(a).**

Applicants' reply must also include a listing of all claims readable upon the elected species. *Id.* Accordingly, Applicants respectfully submit that **at least claims 1-6, 15-31, and 38-41 are readable upon the elected species.**

Additional comments

Applicants appreciate the notice that "Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 C.F.R. § 1.141." Restriction page 3.

CONCLUSION

Applicants look forward to receiving a next Office Action reporting substantive examination of at least claims 1-6, 15-31, and 38-41, and preferably reporting substantive examination of all pending claims 1-31 and 38-41.

If personal contact is deemed advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned at 216.363.9000.

Respectfully submitted,

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